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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/742,124  | 12/22/2000  | Kazunori Arima       | 00862.022075.       | 7920             |
| 5514 7590 05/23/2008<br>FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| USTARIS, JOSEPH G   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2623  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 05/23/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/742,124

**Applicant(s)**

ARIMA, KAZUNORI

**Examiner**

JOSEPH G. USTARIS

**Art Unit**

2623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 19, 21, 23 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 19, 21, 23 and 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed February 20, 2008 have been fully considered but they are not persuasive.

Applicant argues with respect to claims 1, 2, 19, 21, 23, and 51-54 that Jones does not disclose that the system only prohibits printing of the print-prohibition part while the user can still obtain a print-out of the desired content that is not print-prohibited. However, reading the claims in the broadest sense, Jones does meet that limitation of the claims. Jones discloses that the system extracts partial content and stores the partial content (the plurality of coupons stored in 232 of Fig. 8) that includes an information part (an individual coupon out of the plurality of coupons stored in 232) (See col. 14 lines 1-36). The system determines if printing an individual coupon is allowed and does not permit printing if it had been printed before. The printing means print outputs only that portion (e.g. individual coupons that have not been printed before) of the plurality of coupons other than the individual coupons that has been printed before (See col. 14 line 37 – col. 15 line 5 and col. 16 lines 9-24). Therefore, Jones does disclose that the system only prohibits printing of the print-prohibition part (e.g. individual coupons that have been printed before) while the user can still obtain a print-out of the desired content that is not print-prohibited (e.g. individual coupons that have not been printed before).

Furthermore, applicant argues with respect to Mori that the header information is added to the entire print job, not just partial content. However, looking at the whole

combination, Jones discloses printing individual coupons out of a plurality of coupons, wherein the plurality of coupons is considered partial content as discussed above. It is also noted that printing an individual coupon is considered an "entire print job". Therefore, header information is provided for each coupon of the plurality of coupons.

Applicant further argues that at most Jones teaches to effect a prohibition on the printing of a coupon based on whether the coupon has been previously printed. However, reading the claim in the broadest sense, Jones still meets these limitations of the claims. Jones determines whether or not the extracted partial content includes an information part print-output of which is not permitted and wherein the printing means print-output only that portion of the extracted partial content other than the information part when said judging means judge that the extracted partial content includes the information part as discussed in the rejection below.

Applicant also argues that Mori adds nothing to the teaching of Jones. The examiner respectfully disagrees. Jones and Mori both disclose a system where it can determine whether printing is allowed or not based on print information. Jones does not explicitly disclose that the print information is in a header of the partial content. Mori discloses that print information is located within the header. Therefore, Mori discloses that it is well known to place print information in a header of content.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 19, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffa et al. (US005973685A) in view of Jones et al. (US005978013A) and Mori (US006089765A).

Regarding claim 1, Schaffa et al. (Schaffa) discloses a digital broadcast receiving apparatus (See Fig. 1) comprising:

means for setting a digital broadcast program (See Fig. 2, user program selection 20) and a print reservation of partial content (See Fig. 2, user request print 25 of follow-up information (FUI)) which is provided in the program (See col. 2 lines 61-65) and can be displayed on a display when the program plays (the FUI can be displayed when the program is being viewed; See Fig. 2, Play FUI 27), in advance (wherein the user selection of the program and print of the FUI occurs in advance of viewing the program and printing the FUI), based on a table of programs received from a digital broadcast station (See Figs. 1 and 2, elements 3, 4, and 19; col. 2 line 66 – col. 3 line 4; the electronic program guide is a table of programs received from a digital broadcast station);

means for receiving a digital broadcast of the program (See Fig. 1, tuner 14) set by said setting means (user selects a program via setting means as discussed above);

means for extracting the partial content (See Fig. 1, demultiplexer 9; col. 3 lines 54-56) set by said setting means (user request of FUI via setting means as discussed above); and

printing mean for print-outputting the extracted partial content (See Fig. 1, printer 13; col. 3 lines 59-65).

However, Schaffa does not disclose a judging means for judging whether or not extracted partial content includes an information part print-output of which is not permitted, wherein the printing means print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part and the judging means judges based on print information in a header of the partial content, the print information indicating whether printing of the information part is permitted or nor permitted.

Jones et al. (Jones) discloses a digital broadcast receiver that prints supplemental data. Jones discloses that the system has a judging means for judging whether or not extracted partial content (the plurality of coupons stored in 232 of Fig. 8) includes an information part (an individual coupon out of the coupons stored in 232) (See col. 14 lines 1-36) print-output of which is not permitted (the system determines if printing the coupon is allowed and does not permit printing if it has been printed before), wherein the printing means print output only that portion of the extracted partial content (the individual coupons that have not been printed before) other than the information part when the judging means judge that the extracted partial content includes the information part (the individual coupons that have been printed before) (See col. 14 line

37 – col. 15 line 5 and col. 16 lines 9-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital broadcast receiving apparatus disclosed by Schaffa to include the judging means and print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part, as taught by Jones, in order to provide a system that is able to safeguard the information (See col. 2 lines 34-38).

Mori discloses a print system within a network where a computer adds information to the header of data indicating whether printing the data is allowed or not or “print information in a header of the partial content, the print information indicating whether printing of the information part is permitted or not permitted”. The printer reads the header and judges whether to print the data or not (See Fig. 4; column 12 lines 7-25). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the partial content and system disclosed by Schaffa et al. in view of Jones to have a the system judge based on print information in a header of the partial content, the print information indicating whether printing of the information part is permitted or not permitted, as taught by Mori, in order to increase the efficiency of the system by providing a standard location for printing instructions thereby making it easier to locate and to prevent multiple printed copies.

Claim 2 contains the limitations of claim 1 (wherein the digital broadcast receiving apparatus has an “output means” to transfer the print data to the printer (See Schaffa Fig. 1)) and is analyzed as previously discussed with respect to that claim.

Claim 19 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 21 contains the limitations of claim 1 (where inherently the system and system components are run by "computer programs" recorded on "computer-readable recording medium") and is analyzed as previously discussed with respect to that claim.

Claim 23 contains the limitations of claims 1 and 2 (where the system includes a server and head end or "transmitting apparatus" (See Schaffa Fig. 1)) and is analyzed as previously discussed with respect to those claims.

4. Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffa et al. (US005973685A) in view of Jones et al. (US005978013A) and Mori (US006089765A) as applied to claims 1, 2, 19, 21, and 23 above, and further in view of Akerib (US006507362B1).

Regarding claim 51, Schaffa in view of Jones and Mori does not disclose that the system print-output a screen image of the external partial content to be displayed.

Akerib discloses an image generation device for printing out television images. Akerib discloses that the system print-output a screen image of the external partial content to be displayed (See col. 2 lines 57-63 and col. 4 line 49 – col. 5 line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed Schaffa in view of Jones and Mori to have the system print-output a screen image of the external partial content to be



displayed, as taught by Akerib, in order to expand the capabilities of the system thereby enabling the user to capture images seen on the television (See col. 2 lines 57-63).

Furthermore, Jones teaches that the printing means print-output a screen image other than the information part from the screen image when the judging means judge that the extracted partial content includes the information part as discussed above in claims 1, 2, 19, 21, and 23.

Claims 52-54 contains the limitations of claim 51 and is analyzed as previously discussed with respect to that claim.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH G. USTARIS whose telephone number is (571)272-7383. The examiner can normally be reached on M-F 7:30-5 PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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